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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,722	08/27/2001	Ronald A. Schachar	PRES06-00217	5803

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P.O. Drawer 800889
Dallas, TX 75380

07/17/2003

EXAMINER

WILLSE, DAVID H

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 07/17/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,722

Applicant(s)

SCHACHAR, RONALD A.

Examiner

Dave Willse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 61-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on August 27, 2001, is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

The Applicant has again failed to specifically point out the support in the original disclosure for each of the newly presented claims and claim limitations (M.P.E.P. 714.02).

The Applicant has now revised the beginning of the specification to state that the present application is a continuation-in-part (rather than a continuation) of U.S. application serial no. 09/061,168. However, if the Applicant wishes to have the Preliminary Amendment treated as part of the application as originally filed, then the Applicant must file a supplemental declaration, along with the surcharge, referencing said Preliminary Amendment (MPEP 608.04(b); 37 CFR 1.16(e)). (It is also noted that the wrong application serial number for 08/946,975 appears in the Applicant's revision to the beginning of the specification, but this has been corrected by informal examiner's amendment.)

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the generally semicircular and elliptical prostheses (e.g., claim 64) must be shown or the features canceled from the claim. No new matter should be entered.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 61-68, 70, and 74-79 are rejected under 35 U.S.C. 102(b) as being anticipated by Schachar, US 5,354,331. An elongated body and an expanding means as set forth in instant claim 61 are evident from column 7, lines 1-12 and 36-42; column 5, lines 36-41; and the drawings. It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform; it does not constitute a limitation in any patentable sense (*In re Hutchison*, 69 USPQ 138); at least one of the faces and both of the edge surfaces of the patented Schachar band are deemed to be *capable* of contacting the sclera. Regarding claim 62, the expanding means may be viewed as the ridge (or thread) of the screw mechanism described at column 7, lines 8-12.

Claims 69 and 71-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schachar, US 5,354,331. Regarding claim 69, the particular dimensions for each of the "plurality of parts" (column 7, line 2) would have been obvious from anatomical considerations. Regarding claims 71-73, an internal cavity filled with saline solution or the like, a feature well known in the art, would have been obvious from the requirements described at column 6, lines 40-45, and from the diversity of other materials acceptable to Schachar (column 6, lines 45-64).

The Applicant's remarks have been reviewed. Regarding the objections to the drawings, the Applicant asserts that Figures 9 and 22 show semicircular prostheses. By definition, a "semicircle" is "[a] half of a circle as divided by a diameter" or "[s]omething shaped like a half-circle" (*Webster's II New Riverside University Dictionary*, 1984). Figures 9 and 22 suggest a small segment of a ring or an annulus but do not depict a semicircle. The embodiment of Figures 24-27 does not even remotely resemble an ellipse, and the Applicant has certainly not explained how the structure satisfies the definition of the term "elliptical".

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Regarding the Schachar reference (US 5,354,331), the examiner agrees with the Applicant's interpretation of the term "complete band" (column 7, line 3) to mean a ring. An embodiment of the type set forth in column 7, lines 1-12, nonetheless comprises at least one elongated body having a first end and a second end (e.g., column 7, lines 6-8) along with a plurality of surfaces defining at least a portion of said ring. The means for attaching the ends, whether said means is adjustable or not, also serves as a means for expanding the sclera in that it establishes a band "diameter just greater than the natural diameter of the overlying tissue" (column 7, lines 38-39).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, who is available Monday through Thursday and whose telephone number is (703) 308-2903. The supervisor, Corrine McDermott, can be reached at (703) 308-2111. The receptionist's phone number is (703) 308-0858, and the main FAX numbers are (703) 305-3591, 3590.

dhw: D. Willse
July 14, 2003


DAVE WILLSE
PRIMARY EXAMINER
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